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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,431	10/01/2003	Patrick R. Lancaster III	2906.0349-01	5659
22852	7590	12/08/2004	EXAMINER	
FINNEMAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			SIPOS, JOHN	
		ART UNIT		PAPER NUMBER
				3721

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/674,431	LANCASTER ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
John Sipos	3721		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 90-109 and 195-204 is/are pending in the application.  
4a) Of the above claim(s) 1-89 and 110-194 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 90-109, 195-200 and 202-204 is/are rejected.

7)  Claim(s) 201 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/17/03 5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

Applicant's election without traverse of claims 90-109,195-205 in the reply filed on 11/4/2004 is acknowledged. Note that claim 158 was inadvertently grouped in the restriction in both Groups IV and V. The claim is properly grouped with Group V since it is directed to rotating the corner boards during its application to the load.

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### ***REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS***

**Claims 93 and 108 under 35 U.S.C. ' 112, second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The apparatus set forth in claims 14-16,33,34,131 and 132 is not sufficiently associated with the function or step recited in the claims. For example, how does "actuating a clamp" fold the cornerboard? What is the relationship of this clamp to the folding step in the claims? Does the clamp contact the cornerboard? Each of these claims should be reviewed and amended to recite the relationship of the function or the manipulative step to the folding operations.

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### ***REJECTIONS OF CLAIMS BASED ON PRIOR ART***

**Claims 90-109,195-200 and 202-204** are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Morantz (5,535,572) in view of the patent to Newell (5,546,730). The patent to Morantz shows a packaging apparatus comprising of a conveyor 20 that moves a load in direction P (Figure 11a), four cornerboard magazines (see Figure 2), means (148) for gripping a cornerboard from each magazine,

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means for driving the gripping means parallel to direction P (64/66 – Figures 4 & 11b to 11c), means for moving the gripping means transverse to direction P (140 -Figures 4 & 11c to 11d), means for rotating the gripping means and means (144 - Figures 4 & 11b) for wrapping the load and the cornerboard. The patent to Morantz lacks means for folding an unformed cornerboard. The patent to Newell shows a packaging device that uses cornerboards in either unformed or prefolded state (column 5, line 50 et seq. and column 8, line 11 et seq.). The machine comprises a gripper 72 for moving the cornerboards to the load with pivotable portions (see column 8, lines 11 et seq. and Figures 9-11) to fold a cornerboard into its final position. It would have been obvious to one skilled in the art to use unformed cornerboards in the Morantz operation and fold them as taught by Newell so that the cornerboard can be easily handled and shipped in flat condition. The “clamp” of these claims can be read on virtually any machine element of Newell, e.g. the suction elements 71 that clamp onto the cornerboards. Also note that Newell discloses the use of sensors to sense machine/cornerboard positions to control the operation (column 7, lines 55-65). The rotation of the cornerboards 180 degrees instead of 135 degrees (claim 100) and the use of sensors to sense machine operations (claims 102,104) are well known in the packaging art and would have been obvious modifications for their known benefits.

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**ALLOWABLE SUBJECT MATTER**

Claim 201 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at 571-272-4467.



John Sipos  
Primary Examiner  
Art Unit 3721

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